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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09-936,526 | 12/05/2001 | Markus Oechsle | P21469 | 4387 |

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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER
HALPERN, MARK

ART UNIT PAPER NUMBER
1731

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,526

Applicant(s)

OECHSLE ET AL.

Examiner

Mark Halpern

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5/7/03.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

- 1) Acknowledgement is made of Amendment received 5/7/2003. Applicants amend claims 31, 33-38, 43, 50, 51, 71, 77, and 81-87.

Allowable Subject Matter

- 2) The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for indication of allowable subject matter is that the cited prior art does not show:

a method of operating a machine for manufacturing and/or refining a material web wherein the machine includes at least one machine section, said method including detecting data in a plurality of measurement zones using at least one measurement device that detects data while moving along at least two degrees of freedom of movement (claim 31);

a measurement system for the use in operating a machine for manufacturing and/or refining a material web wherein the machine includes at least one machine section, the system including measurement devices detecting data while moving along at least two degrees of freedom of movement (claims 77, 87).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3) Claim 31 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 100 of copending Application No. 09/936,516. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claim 31 discloses a method of operating a machine for manufacturing and/or refining a material web "using at least one measurement device that detects the data while moving along at least two degrees of freedom of movement," and the copending Application 09/936,516, claim 100, discloses a method for determining characteristics of a running material web "moving the at least one measuring device along the at least two degrees of freedom of movement".

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4) Claims 77, 87, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33, 99 of copending Application No. 09/936,516. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the present claims 77, 87, disclose a measurement system for use in operating a machine for manufacturing and/or refining a material web having "measurement devices detecting the data while moving along at least two degrees of freedom of movement," and the copending Application 09/936,516, claims 33, 99, disclose an apparatus for determining characteristics of a running material web having "at least one measuring device" that "moves along the at least two degrees of freedom of movement during data collection".

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Amendment

- 5) Claims 31-47, 50-59, 62, 64-66, 69-87, rejection under 35 U.S.C. 102(b) as being anticipated by Clark, is withdrawn in view of amended claims.
- 6) Claims 48-49, rejection under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Fiedler, is withdrawn in view of amended claims.
- 7) Claims 60-61, rejection under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Fiore, is withdrawn in view of amended claims.
- 8) Claim 63 rejection under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Kustermann, is withdrawn in view of amended claims.
- 9) Claims 67-68, rejection under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Arno, is withdrawn in view of amended claims.
- 10) Claims will be allowed upon resolution of the double patenting rejection.

Conclusion

11) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

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Mark Halpern
Patent Examiner
Art Unit 1731

June 1, 2003